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09/385,802	08/30/1999	KEVIN REMINGTON JOSEPH BARTHOLOMEN DONOVAN	4031/1	9671

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EXAMINER
CHANKONG, DOHM

ART UNIT	PAPER NUMBER
2152	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/385,802	BARTHOLOMEN DONOVAN, KEVIN REMINGTON JOS	
	Examiner	Art Unit	
	Dohm Chankong	2152	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 July 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *16-20,22 and 104-121* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *16-20,22 and 104-121* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1> This action is in response to Applicant's remarks and amendment. Claim 21 has been cancelled. Claims 104-121 have been added. Thus, claims 16-20, 22 and 104-121 are presented for further examination.

2> This is a final rejection.

Response to Arguments

3> Applicant's arguments with respect to claims 16-20, 21 and 103 have been considered but are moot in view of the new ground(s) of rejection necessitated by Applicant amendment [specifying now a first and second user associated with a first and second realm respectively].

4> Furthermore, Applicant's arguments have been fully considered but are not persuasive. Applicant is arguing in substance that the Auerbach and Kim references cannot be combined for a variety of reasons, including impermissible change in operation, Kim teaches away from Auerbach and no motivation to combine.

The basis of Applicant's arguments rests on the fact that Auerbach and Kim are directed towards disparate network architectures, a client-server system and a peer-to-peer system respectively. Examiner believes that these arguments would be applicable if the rejections relied on Kim's peer-to-peer functionality in some way, but this does not seem to be the case.

As discussed in Applicant's remarks, Auerbach discloses a central device that regulates communications between users of disparate networks or providers. Auerbach failed to expressly disclose determining a current IP address of the second user to establish this communication. Kim was utilized to help cure this deficiency. Kim further discloses that the IP addresses are stored in a central location, such as his databases, that is accessible by the peers in the network [see Figure 2 «item 218, 264» | column 4 «lines 1-4»]. It seems clear then that Kim's IP address information is *centrally* located, rather than being distributed amongst the peers. Therefore, Kim's peer-to-peer functionality is not being relied upon to establish the use of a IP address database within Auerbach. As it is this IP address database that is being relied upon in the rejection, it would seem reasonable that Kim's database functionality can be applied to Auerbach's central device for the benefit of being able to retrieve IP address information of other users.

Moreover, Auerbach's system is not being violently altered such that his operation is changed because the use of IP addresses are implicit in his system. It is well known and established in the art that an IP address is essential to have a network presence as Auerbach's users do [they communicate over the network]. Thus, when his users wish to establish communication session to other users that are on his contact list, the IP addresses of for each user are a requirement to affect the establishment of the session. In Auerbach, as his conversion platform seems responsible for establishing such a session, the platform must know the IP addresses of each user. Kim's teachings of a database that contains the IP address mapping provide a useful means for allowing Auerbach's platform to ascertain the user IP addresses to establish the session. Therefore, Kim's use of the IP address database

does not teach away from Auerbach, but supplements the conversion platform's ability to establish communication sessions between users.

Furthermore, Auerbach discloses that his invention is amenable to communications between peer devices [column 4 «lines 20-33»].

As to Applicant's argument concerning motivation, see the discussion above. Kim's system teaches what was implicit in Auerbach's system. The use of IP addresses to establish network communications is well known in the art. Further, Auerbach discloses utilizing contact lists and email addresses and storing them in an accessible storage location [column 5 «lines 49-62»]. Thus, Kim's disclosure of an IP address database supplements and improves Auerbach by providing IP addresses in addition to Auerbach's use of email addresses (which can be considered IP addresses as well).

Based on these remarks, the rejections under Auerbach and Kim are maintained.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5> Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Claim 17 is rejected for lacking proper antecedent basis : "the IM database".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6› Aravamudan is directed towards a unified messaging system to provide messaging capability to a plurality of communication devices, modes and channels. Aravamudan thus allows devices in different networks to communicate with one another in a user-friendly manner.

7› Claims 16-20, 22, 103, 112 and 113 are rejected under 35 U.S.C § 102(e) as being anticipated by Aravamudan et al, U.S Patent No. 6.301.609 ["Aravamudan"].

8› As to claim 16, Aravamudan discloses a method of conducting an instant messaging session between a first user and a second user over the Internet, said first and second users being associated with a first realm and second realm respectively [Figure 3 «items 184 and 192»], each said realm being accessible via the Internet using a protocol characteristic to said realm [column 5 «lines 32-51» | column 7 «lines 3-20» where : if a PSTN network, for instance, a PSTN exchange number is used], each said user getting access to the Internet via

one of a respective first and second device [Figure 2], at least one of said first and second devices having a storage media storing the protocol characteristic of the other realm [column 7 «lines 3-20» | column 12 «lines 9-30»], the method comprising the steps of:

determining a current IP address of the second user [column 4 «lines 3-25» | column 9 «lines 50-57»];

establishing a connection between said first and second users using said current IP address and said protocol characteristic as part of an instant messaging session [column 9 «lines 45-57» | column 11 «lines 8-45»].

9› As to claim 17, Aravamudan discloses sending a message to the IM database indicating the corresponding user is online [column 9 «line 64» to column 10 «line 15»].

10› As to claim 18, Aravamudan discloses retrieving said address form said IM database [column 5 «lines 25-31» | column 6 «lines 18-31» | column 9 «lines 49-57»].

11› As to claim 19, Aravamudan discloses sending a connection request from the first to the second device for establishing said instant messaging session [column 9 «lines 10-22»].

12› As to claim 20, Aravamudan discloses generating a response to said connection request by said second device accepting said connection request [column 9 «lines 10-22» | column 10 «lines 37-44» | column 11 «lines 35-45»].

13> As to claim 22, Aravamudan discloses displaying a window on the screen of said first and second devices, said window indicating a list of active users [column 6 «lines 18-31»].

14> As to claim 103, Aravamudan discloses displaying a window with a message area, said message area being used to indicate messages between said users [column 10 «lines 37-41»].

15> As to claim 112, Aravamudan discloses a method of conducting an instant messaging session between a first user and a second user over the Internet,

said first user associated with a first realm having a first protocol characteristic [column 7 «lines 3-20» : one user can be in a packet network, thus Aravamudan discloses a characteristic that marks the user as being in a packet network],

said first user connected to the internet using said first protocol characteristic [column 6 «lines 18-31 and 45-67» : first user establishes a network presence with the network address],

said second user associated with a second realm having a second protocol characteristic [column 7 «lines 3-20» : another user can be in a PSTN network, thus Aravamudan discloses a characteristic that marks the user as being in a PSTN network,

said second user connected to the Internet using said second protocol characteristic [column 6 «lines 19-31 and 45-67»],

the method comprising the steps of:

determining a current IP address of the second user [column 4 «lines 3-25» | column 9 «lines 50-57»];

establishing a connection between said first and second users using said current IP address and said second protocol characteristic as part of an instant messaging session [column 9 «lines 45-57» | column 11 «lines 8-45»].

16› As to claim 113, Aravamudan discloses a method of conducting an instant messaging session between a first user and a second user over the Internet,

said first user associated with a first realm having a first protocol characteristic [column 7 «lines 3-20» : one user can be in a packet network, thus Aravamudan discloses a characteristic that marks the user as being in a packet network],

said first user connected to the internet using said first protocol characteristic [column 6 «lines 18-31 and 45-67» : first user establishes a network presence with the network address],

said second user associated with a second realm having a second protocol characteristic [column 7 «lines 3-20» : another user can be in a PSTN network, thus Aravamudan discloses a characteristic that marks the user as being in a PSTN network,

said second user connected to the Internet using said second protocol characteristic [column 6 «lines 19-31 and 45-67»],

the method comprising the steps of:

displaying an instant message from said first user to said second user using said current IP address and said second protocol characteristic [column 4 «lines 20-25» | column 7 «lines 3-20»].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

17› Claims 104-111 and 114-121 are rejected under 35 U.S.C § 103(a) as being unpatentable over Aravamudan, in view of Gudjonsson et al, U.S Patent No. 6.564.261 ["Gudjonsson"].

18› As to claim 104, Aravamudan does not expressly disclose encrypting instant messages but encryption of network data is rather ubiquitous and even expected in the art, as evidenced by Gudjonsson.

19› In a related field of invention Gudjonsson is directed towards establishing communication sessions between users over a variety of networks. Gudjonsson discloses encrypting an instant message during the instant message session [abstract | column 2 «lines 16-23» | column 11 «lines 38-43»]. It would have been obvious to one of ordinary skill in the art to incorporate encryption services into Aravamudan's communication system for the desirable function of having secured transmissions of network messages between users.

20› As to claims 105 and 106, Aravamudan discloses a handheld and a palmtop computer [Figure 2].

21› As to claim 107, Aravamudan does not expressly disclose a WebTV device. However, Aravamudan states that his invention is not limited to the disclosed devices, and is relevant to any data or communication devices synchronized with a network means [column 3 «lines 26-37»]. As a WebTV device is well known in the art, it would have been obvious to one of ordinary skill in the art to incorporate such devices into Aravamudan's network communication system to increase the number of devices with which he is compatible. Furthermore, selection of network devices is merely a design choice and does not provide any patentable distinction over the prior art references.

22› As to claim 108, Aravamudan discloses a method of conducting an instant messaging session, the method comprising:

establishing an instant messaging session over an Internet protocol network between a first user device and a second user device [column 3 «lines 26-52»], each said user device corresponding to a user name [column 6 «lines 50-63.], each said user name corresponding to a different realm [column 6 «lines 27-29 and 50-67» | column 7 «lines 9-20»] , each said realm having a protocol characteristic to the realm [column 7 «lines 3-20» | column 11 «lines 7-34»], each said user device having an Internet protocol address in the realm corresponding to the user name [column 4 «lines 20-25» | column 9 «lines 49-57»].

23> Aravamudan does not expressly disclose encrypting instant messages but encryption of network data is rather ubiquitous and even expected in the art, as evidenced by Gudjonsson.

In a related field of invention Gudjonsson is directed towards establishing communication sessions between users over a variety of networks. Gudjonsson discloses encrypting an instant message during the instant message session [abstract | column 2 «lines 16-23» | column 11 «lines 38-43»]. It would have been obvious to one of ordinary skill in the art to incorporate encryption services into Aravamudan's communication system for the desirable function of having secured transmissions of network messages between users.

24> As to claims 109-111, as they do not teach or further define over the previously claimed rejections, they are similarly rejected for at least the same reasons set forth for claims 105-107.

25> As to claim 114, Aravamudan discloses an instant message receiving system, said system including:

a first user device connected to an Internet Protocol Network and associated with a first Internet Protocol address, a first user name, and a first realm, said first realm employing a first protocol characteristic [column 3 «line 26» to column 4 «line 25»]; and

a second user device connected to said Internet Protocol Network and associated with a second Internet Protocol address, a second user name, and a second realm, said second realm employing a second protocol characteristic [column 3 «line 26» to column 4 «line 25» | column 7 «lines 3-20»];

wherein said first protocol characteristic is different from said second protocol characteristic [column 3 «lines 3-20» : PSTN v. packet networks].

Aravamudan does not expressly disclose encrypting instant messages but encryption of network data is rather ubiquitous and even expected in the art, as evidenced by Gudjonsson.

26› In a related field of invention Gudjonsson is directed towards establishing communication sessions between users over a variety of networks. Gudjonsson discloses encrypting an instant message during the instant message session [abstract | column 2 «lines 16-23» | column 11 «lines 38-43»]. It would have been obvious to one of ordinary skill in the art to incorporate encryption services into Aravamudan's communication system for the desirable function of having secured transmissions of network messages between users.

27› As to claims 115-117, as they do not teach or further define over the previously claimed rejections, they are similarly rejected for at least the same reasons set forth for claims 105-107.

28› As to claims 118-121, as they do not teach or further define over the previously claimed limitations they are similarly rejected for at least the same reasons set forth above for claims 104 and 108-117.

29› Claims 16 and 22 are rejected under 35 U.S.C § 103(a) as being unpatentable over Auerbach, U.S Patent No. 6.549.937 ["Auerbach"], in view of Kim, U.S Patent No. 6.490.274 ["Kim"].

30› As to claim 16, Auerbach discloses a method of conducting an instant messaging session between a first user and a second user over the Internet, said first and second being associated with a first realm and a second realm respectively [column 2 «lines 9-15» : different users, different service providers], each realm being accessible via the Internet using a protocol characteristic to the realm (col. 2, lines 19-28), each said user getting access to the Internet via one of a respective first and second device (fig. 3, client 102), at least one of said first and second devices having a storage media storing the protocol characteristic of the other realm (see fig. 3, protocol services 130 and 132) the method comprising the steps of:

While Auerbach discloses the user logging on to the primary service provider using established logon procedures, and Auerbach is not specifically disclose the steps of determining a current IP address of the second user, and establishing a connection between the first and second users using the current IP address and the protocol characteristic. As discussed previously, the use of IP addresses to connect network users is implicit in Auerbach. Auerbach clearly discloses establishing network sessions between the users through his conversion platform; the platform would necessarily need to know the IP addresses of each user to do so. Further, Auerbach discloses establishing sessions based on the email addresses of users [column 1 «lines 46-61»]. It is well known in the art that email

addresses are inherently tied to IP addresses. Furthermore, the step of searching for IP addresses and utilizing said IP addresses are well known in the art as evidenced by Kim.

31> In similar art, Kim discloses a peer-to-peer telephony system for supplying service using a cable network that discloses when a first or second cable phone initiates a call, the network segment units each have a head end unit that read IP addresses stored in the directory unit based on a received telephone number of a second cable phone and determines a session using an internet protocol from the read IP addresses to set a call path with the first cable phone (see Kim, abstract and col. 4, lines 56-65). It would have been obvious to supplement the system disclosed by Auerbach to include the IP address database taught by Kim in order to allow the user to connect to and engage particularly in instant messaging sessions regardless of their different protocol or service providers used. As Auerbach suggests searching for the email addresses of users to establish communication sessions, utilization of Kim's IP address database would have been an obvious modification to the system disclosed by Auerbach.

32> In considering claim 22, Auerbach discloses displaying a window on the screen of the first and second devices, the window indicating a list of active users (see Fig 4B).

33> Claims 17-20 and 103 are rejected under 35 U.S.C. 103(a) as being unpatentable over Auerbach and Kim, in view of Appelman, U.S. Patent No. 6.750881.

34> In considering claim 17, while the combined system of Auerbach and Kim discloses the system substantially as claimed, it does not disclose that sending a message to the IM database indicating the corresponding user is online. Nonetheless, the aforementioned limitation is a well-known feature of instant messaging systems as evidenced by Appelman.

35> In similar art, Appelman discloses a real time notification system that tracks, for each user, the logon status of selected co-users. Appelman further discloses that when a user logs on the logon system notifies the Buddy List System about the user (i.e. passes the User's ID, address, or screen name to the Buddy List System) (see Appelman col. 6, lines 57-5%. It would have been obvious to modify the combined system of Auerbach and Kim to include the steps of sending a message to an IM database indicating the corresponding user is online and the current IP address in order to more accurately track user relationships and maintain knowledge of the users and processes on the system. Therefore, the limitations would have been an obvious modification to the combines system of Auerbach and Kim.

36> In considering claim 18, the combined system of Auerbach, Kim, and Appelman discloses wherein the step of determining the current P address comprises retrieving the address from the IM database (see Kim col. 4, lines 56-61).

37> In considering claim 19, Auerbach discloses sending a connection request from the first to the second device for establishing the instant message session (see Auerbach col. 11 lines 48-50).

38› In considering claim 20, Auerbach discloses generating a response to the connection request by the second device accepting the connection request (see Auerbach col. 11, lines 1-3).

39› In considering claim 103, Auerbach discloses displaying the window with a message area the message area being used to indicate messages between users (see Appelman Fig. 9).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dohm Chankong whose telephone number is 571.272.3942. The examiner can normally be reached on Monday-Thursday [7:00 AM to 5:00 PM].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571.272.3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DC

BUNJOB JAROENCHONWANIT
PRIMARY EXAMINER